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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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09/963,844

09/26/2001

Joseph E. Wilkes

APP 1304-US

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02/15/2006

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EXAMINER

YAO, KWANG BIN

ART UNIT

PAPER NUMBER

2667

DATE MAILED: 02/15/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/963,844

Applicant(s)

WILKES ET AL.

Examiner

Kwang B. Yao

Art Unit

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 29 November 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-20 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 26 September 2001 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

## **DETAILED ACTION**

### ***Response to Arguments***

1. Applicant's arguments with respect to claims 1-20 have been considered but are moot in view of the new ground(s) of rejection.

### ***Drawings***

2. The drawings are objected to because the words in Figure 5 are too small to read. Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended." If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

***Claim Rejections - 35 USC § 102***

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

4. Claims 1-20 are rejected under 35 U.S.C. 102(e) as being anticipated by Proctor et al. (US 6,708,036).

Proctor et al. discloses a communication system comprising the following features:

regarding claim 1, 1. A method for communicating in a system that includes at least a first base station (Fig. 3, Base Station 110\_1) connected to a packet network (Fig. 3, Internet 340; Fig. 4, IP network 480), the first base station (Fig. 3, Base Station 110\_1) serving a first cell (Fig. 2, cell 430), said method comprising: connecting a second base station (Fig. 3, Base Station 110\_3) to the packet network (Fig. 3, Internet 340; Fig. 4, IP network 480); the second base station (Fig. 3, Base Station 110\_3) automatically (column 5, lines 55-57; column 10, lines 39-40) identifying the first base station (Fig. 3, Base Station 110\_1); receiving, at the first base station (Fig. 3, Base Station 110\_1), communications from a wireless device in the first cell (Fig. 2, cell 430) served by the first base station (Fig. 3, Base Station 110\_1); and handing off the wireless device from the first cell (Fig. 2, cell 430) to a second cell (Fig. 2, cell 470) served by the second base station (Fig. 3, Base Station 110\_3) by a two way exchange of information between the first base station (Fig. 3, Base Station 110\_1) and the second base station (Fig. 3, Base Station 110\_3); regarding claim 2, the first base station (Fig. 3, Base Station 110\_1) and the second base station (Fig. 3,

Base Station 110\_3) exchanging information over the packet network (Fig. 3, Internet 340; Fig. 4, IP network 480) to determine a coverage area (column 3, lines 51-62) for the second cell (Fig. 2, cell 470) served by the second base station (Fig. 3, Base Station 110\_3); regarding claim 3, wherein the step of the second base station (Fig. 3, Base Station 110\_3) identifying the first station includes: the second base station (Fig. 3, Base Station 110\_3) transmitting to a carrier database (Fig. 3, Carrier Database 350) a message requesting addresses for other base stations connected to the packet network (Fig. 3, Internet 340; Fig. 4, IP network 480); the carrier database (Fig. 3, Carrier Database 350) transmitting an address for the first base station (Fig. 3, Base Station 110\_1) to the second base station (Fig. 3, Base Station 110\_3); and the second base station (Fig. 3, Base Station 110\_3) transmitting a message to the first base station (Fig. 3, Base Station 110\_1) using the address for the first base station (Fig. 3, Base Station 110\_1); regarding claim 4, the second base station (Fig. 3, Base Station 110\_3) transmitting a message to a central database requesting an address for the carrier database (Fig. 3, Carrier Database 350); and the central database, in response to receiving the message from the second base station (Fig. 3, Base Station 110\_3), transmitting an address for the carrier database (Fig. 3, Carrier Database 350) to the second base station (Fig. 3, Base Station 110\_3); regarding claim 5, wherein the step of the second base station (Fig. 3, Base Station 110\_3) identifying the first base station (Fig. 3, Base Station 110\_1) includes: the second base station (Fig. 3, Base Station 110\_3) transmitting a broadcast message on the packet network (Fig. 3, Internet 340; Fig. 4, IP network 480); and the first base station (Fig. 3, Base Station 110\_1) transmitting a reply message to the second base station (Fig. 3, Base Station 110\_3) in response to receiving the broadcast message; regarding claim 6, wherein the wireless device includes a computer; regarding claim 7, wherein the

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computer includes a personal digital assistant PDA; regarding claim 8, wherein the wireless device uses the mobile Internet protocol IP to send the communication to the first base station (Fig. 3, Base Station 110\_1); regarding claim 9, wherein the first base station (Fig. 3, Base Station 110\_1) connects to the packet network (Fig. 3, Internet 340; Fig. 4, IP network 480) via an Ethernet compatible interface; regarding claim 10, a first base station (Fig. 3, Base Station 110\_1) that controls communications with one or more wireless devices (Fig. 4, wireless device 420a, 420b, 420c, ..., 420n) in a first cell (Fig. 2, cell 430); a second base station (Fig. 3, Base Station 110\_3) that controls communications with one or more wireless devices (Fig. 4, wireless device 420a, 420b, 420c, ..., 420n) in a second cell (Fig. 2, cell 470); and a packet network (Fig. 3, Internet 340; Fig. 4, IP network 480) connecting the first base station (Fig. 3, Base Station 110\_1) and the second base station (Fig. 3, Base Station 110\_3); wherein the first base station (Fig. 3, Base Station 110\_1) automatically (column 5, lines 55-57; column 10, lines 39-40) identifies the second base station (Fig. 3, Base Station 110\_3) after being connected to the packet network (Fig. 3, Internet 340; Fig. 4, IP network 480); and wherein the first base station (Fig. 3, Base Station 110\_1) and the second base station (Fig. 3, Base Station 110\_3) engage in a two way information exchange over the network to hand off (column 5, lines 31-45) one or more of the wireless devices (Fig. 4, wireless device 420a, 420b, 420c, ..., 420n) in the first cell (Fig. 2, cell 430) from the first cell (Fig. 2, cell 430) to the second cell (Fig. 2, cell 470); regarding claim 11, wherein the first base station (Fig. 3, Base Station 110\_1) is further capable of engaging in a two way exchange of information with the second base station (Fig. 3, Base Station 110\_3) to determine a coverage area (column 3, lines 51-62) for the first cell (Fig. 2, cell 430); regarding claim 12, wherein the first base station (Fig. 3, Base Station 110\_1) further transmits to a carrier

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database (Fig. 3, Carrier Database 350) a message requesting addresses for other base stations connected to the packet network (Fig. 3, Internet 340; Fig. 4, IP network 480), receives from the carrier database (Fig. 3, Carrier Database 350) an address for the second base station (Fig. 3, Base Station 110\_3), and transmits a message to the second base station (Fig. 3, Base Station 110\_3) using the address for the second base station (Fig. 3, Base Station 110\_3); regarding claim 13, wherein the second base station (Fig. 3, Base Station 110\_3) further transmits a message to a central database requesting an address for the carrier database (Fig. 3, Carrier Database 350), receives from the central database the address for the carrier database (Fig. 3, Carrier Database 350), and transmits a message to the carrier database (Fig. 3, Carrier Database 350) using the address for the carrier database (Fig. 3, Carrier Database 350); regarding claim 14, wherein the first base station (Fig. 3, Base Station 110\_1) further transmits a broadcast message on the packet network (Fig. 3, Internet 340; Fig. 4, IP network 480), and receives a reply message from the second base station (Fig. 3, Base Station 110\_3) in response to the broadcast message; regarding claim 15, wherein at least one of the wireless devices (Fig. 4, wireless device 420a, 420b, 420c, ..., 420n) includes a cellular phone; regarding claim 16, wherein at least one of the wireless devices (Fig. 4, wireless device 420a, 420b, 420c, ..., 420n) includes a computer; regarding claim 17, wherein the computer includes a personal digital assistant PDA; regarding claim 18, wherein the wireless device communicates with the first base station (Fig. 3, Base Station 110\_1) using mobile internet protocol IP; regarding claim 19, wherein the first base station (Fig. 3, Base Station 110\_1) connects to the packet network (Fig. 3, Internet 340; Fig. 4, IP network 480) via an Ethernet compatible interface; regarding claim 20, a base station for communicating with a wireless device, comprising: a network interface that connects to a packet

network (Fig. 3, Internet 340; Fig. 4, IP network 480); an antenna interface that connects to an antenna for communicating with one or more wireless devices (Fig. 4, wireless device 420a, 420b, 420c, ..., 420n) in a first cell (Fig. 2, cell 430) served by the base station; a memory that includes: a program (column 3, lines 59-62) for automatically (column 5, lines 55-57; column 10, lines 39-40) identifying other base stations, and a program (column 3, lines 59-62) for engaging in a two way information exchange with one of the other base stations to hand off (column 5, lines 31-45), from the first cell (Fig. 2, cell 430) to a second cell (Fig. 2, cell 470) served by the other base station, one or more of the wireless devices (Fig. 4, wireless device 420a, 420b, 420c, ..., 420n) in the first cell (Fig. 2, cell 430); and a processor that executes the program (column 3, lines 59-62). See column 1-10.

### ***Conclusion***

5. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kwang B. Yao whose telephone number is 571-272-3182. The examiner can normally be reached on M-F.

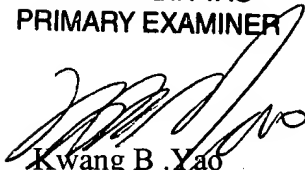
If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Chi H. Pham can be reached on 571-272-3179. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.



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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

KWANG BIN YAO  
PRIMARY EXAMINER



Kwang B. Yao  
February 8, 2006